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OFFICIAL

Our Case No. 10022/112

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Kishore Swaminathan et al.

Serial No. 09/521,235

Filing Date: March 8, 2000

For: Knowledge Management Tool
Proposal Wizard

Examiner Maikhanh Nguyen

Group Art Unit No. 2176

RESPONSE UNDER 37 C.F.R. § 1.116

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

1. This communication is responsive to the final Office Action mailed on February 10, 2004 and to the Advisory Action mailed on April 22, 2004. Applicants respectfully request that the Examiner fully consider the following remarks. Should these remarks not be considered persuasive, Applicants request an Advisory Action with the Examiner's remarks be provided so that a clear record may be established to put the case in form for appeal. Applicants understand that the Amendment filed on April 9, 2004, has been entered.

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Response to Advisory Action mailed April 22, 2004
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2. The Advisory Action states that U.S. Pat. No. 5,864,871, to Kitain ("Kitain"), anticipates claims of the present invention. The Advisory Action states in particular that Kitain discloses "a list of companies and place the list in a form from which the user can choose a company," citing Kitain, column 21, lines 36-78 (see Advisory Action, p. 2, lines 6-7), and that this reads on "industries associated with the client." The final office action also cited Kitain as disclosing "lists of industries that the user may choose . . . industry groups 210," citing col. 39, line 40, to col. 40, line 19, and Fig. 3.

3. Kitain discloses "a list of industries," as stated in the rejection and the Advisory Action, while Applicants' Claim 1 recites "presenting a list consisting of industries associated with the client" (emphasis added). The transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. M.P.E.P. 2111.03. Thus, the list can include ONLY ("consisting of") those industries associated with the client, such as by prior association or linking in a database. Kitain makes a clear distinction between companies and industries. See, for example, Kitain's Fig. 3, in which the screen displays an upper box (208) with companies, such as "Chicago Corporation," while the lower box (210) lists industries, but does not provide any indication that the industries are only those associated with the selected company. Thus, Kitain could conceivably associate "companies" with a user, but not with industries.

4. Moreover, another point of confusion seems be to the Claim 1 limitation of "a client." Applicants believe that the Examiner confuses the user with the client. The specification clearly distinguishes the "user" interacting with the method of Claim 1 from "a client" when it states, "First, a name of one or more clients which may be relevant to a proposal is received. The name may be input or selected by the user. A list of industries associated with the client(s) is presented to the user." Specification, p. 4, lines 2-5 (emphasis added).

In Kitain, the companies are associated not with the clients (i.e., companies), but with the user because, as stated in the Office Action and the Advisory Action, "each user has authorization to access a subset of the information stored at the repository server . . . reports can be access only by its employees and certain investors [users]." Advisory Action, p. 2, lines 3-6.

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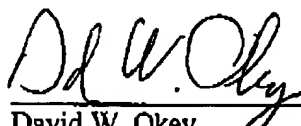
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The Office Action seems to equate the "user" of Kitain with the client, while in the present application and claims, the "user" is different from the "client." Kitain therefore does not disclose or suggest the step of Claim 1 that requires the industries be associated with the client (i.e. companies).

5. Further, Kitain does not disclose or suggest elements of many of the dependent claims of the application. Claim 2, for example, claims the method of Claim 1, in which an alternate list "consisting of companies NOT associated with the client" is presented (emphasis added). Kitain does not disclose this step. Claim 3 recites steps of displaying "topics associated with the client" and allowing selection of at least one of the topics for insertion of information relating to the selected topics in the dossier. Kitain does not disclose these steps of Claim 3, nor does Kitain disclose or suggest arranging a dossier in sections according to people, documents and projects, as claimed in Claim 4. Claim 20 recites that the arranged sections include displayed expandable nodes and subnodes. Kitain does not teach this limitation and also fails to teach many other limitations of the claims.

6. Because Kitain does not anticipate or make obvious the claimed invention, Applicants request the Examiner to reconsider the application and to grant allowance of the application.

Respectfully submitted,


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